

REMARKS

In response to the Advisory Action mailed on June 21, 2005, Applicant wishes to enter the following remarks for the Examiner's consideration. Claims 1-29 and 31-40 are pending in the application.

The Advisory Action indicates that the declaration filed June 9, 2005 is ineffective to overcome the Schmit reference. The examiner states that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Schmit reference and that the four-page invention disclosure does not establish any date prior to the effective date of the Schmit reference. Examiner West further states that the evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Schmit reference to a reduction to practice. Applicant will address each of these issues in turn.

With regard to the issue of conception, the examiner is respectfully directed to 37 CFR 1.131 and MPEP 715.07. 37 CFR 1.131(b) states that the showing of facts will establish "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application...." MPEP 715.07 II. Establishment of Dates, second paragraph, instructs as follows: "When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the

actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, *he or she may merely allege that the acts referred to occurred prior to a specified date.* However, the actual dates of acts relied on to establish diligence must be provided....” (emphasis added)

Based upon the foregoing authorities, Applicant respectfully submits that, on the issue of establishing conception of the invention prior to the effective date of the Schmit reference, Applicant need only merely allege that the acts referred to occurred prior to the effective date of the Schmit reference. This Applicant has done through the declaration of inventor Ed O. Schlotzhauer.

On the issue of diligence, Applicant submits that paragraph 3 of the declaration sets forth, with particularity, the acts and supporting documentation, Exhibits A-F, thereof that establishes diligence of Applicant from a time just prior to the effective date of the Schmit reference to the filing date of the instant application.

Accordingly, Applicant respectfully requests that the rejections to the claims be withdrawn and a Notice of Allowability of all pending claims be forthcoming at the Examiner's earliest convenience. Please contact the undersigned if you have any questions regarding this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Renee' Michelle Leveque', with a long, sweeping horizontal line extending to the right.

Renee' Michelle Leveque

Leveque IP Law, P.C.
Reg. No. 36,193
221 East Church Street
Frederick, Maryland 21701
301-668-3073
Attorney for Applicant(s)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re: Patent Application of:

Inventor(s): Ed O. Schlotzhauer et al.

Filed: 18th September 2001

Application No.: 09/955,796

Confirmation No.: 1044

Group Art Unit: 2857

Examiner: Jeffrey R. West

Docket Number: 10010804-1

Title: A Method for User Variation of a Measurement Process

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

DECLARATION OF ED O. SCHLOTZHAUER UNDER 37 CFR §1.131

I, Ed. O. Schlotzhauer, being duly sworn, state as follows:

FACTS

1. I believe that I am a first and original inventor of the subject matter of pending U.S. patent application Patent Application No. 09/955,796 filed on September 18, 2001.
2. I, together with my co-inventors Gary W. Beyer and Tammy Jo Risa, conceived of and submitted the four-page invention disclosure describing that which was conceived on a date prior to June 29, 2001. A copy of the invention disclosure with redacted dates is attached hereto as Exhibit F.
3. Evidence of diligence from a date prior to June 29, 2001 to the filing of my pending U.S. patent application on September 18, 2001 is demonstrated by the following facts:
 - a. I spoke with patent attorney Michelle Larson, who was assigned by Agilent to draft the patent application, on a date prior to June 13, 2001. See Exhibit A, which is a copy of an e-mail sent June 13, 2001 from Agilent corporate patent counsel Cindy Mitchell (email address: cindy_mitchell@agilent.com) to Agilent patent administrative assistant Sue Hebert (email address: sue_hebert@agilent.com).
 - b. I received a first draft of the patent application and provided responsive comments to Michelle Larson on or before September 11, 2001. See Exhibit B, which is a printout of a server directory at the offices of Michelle Larson that contains a listing of the application drafts and the date and times they were saved.
 - c. I received, reviewed and approved a final draft of the patent application sometime between September 11, 2001 and September 18, 2001. See Exhibit B showing the final draft of the patent application saved September 11, 2001 and

Exhibits C & D which are e-mails sent by Michelle Larson (e-mail address: michelle@larsonpc.com) to Sue Hebert (email address: sue.hebert@agilent.com) on September 11, 2001.

d. The final patent application approved by me and based on this invention disclosure was filed with the U.S. Patent Office on September 18, 2001 as U.S. Patent Application No. 09/955,796.

e. The filing of this application with the U.S. Patent Office was confirmed by Sue Hebert in an e-mail from Sue Hebert (email address: sue.hebert@agilent.com) to Michelle Larson (e-mail address: michelle@larsonpc.com). See Exhibit E.

4. Based upon my review of the above-referenced patent application, the subject matter of at least claims 1 and 21 is described on pages two to four under the heading "Description of the Invention" and is also found on pages 5-15 of the Specification filed as U.S. Patent Application No. 09/955,796.

The information and opinions provided herein are sworn to be true and to be originated by me. I further declare that all statements made of my own knowledge are true and all statements made on information and believe are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and may jeopardize the validity of the present application or any patent issued thereon.

7/11/05
Date

Ed O. Schlotzhauer
Ed O. Schlotzhauer



Michelle Larson

EXHIBIT A

From: <cindy_mitchell@agilent.com>
To: <sue_hebert@agilent.com>; <michelle@larsonpc.com>
Sent: Wednesday, June 13, 2001 7:19 PM
Attach: MITCHELL,CINDY (A-FICollins,ex1).vcf [REDACTED]
Subject: RE: 10010804-1 application

Sue,

It is my understanding that Michelle has investigated this with the inventor and the manager of the project these inventions are from, therefore you have my approval to change these filing dates.

Michelle, if the relevant dates change, please keep me in the loop so that we can change our system.

Thanks,

Cindy Mitchell, Corporate Counsel
Intellectual Property Section, Legal Depart.
Agilent Technologies, Inc.
815 14th Street SW, MS DL432
Loveland, CO 80537
970-679-3136

6/13/2001

EXHIBIT B

located

Microsoft Outlook

Inbox - Microsoft Outlook

File Edit View Favorites Tools Actions Help

New Open Reply Reply to All Forward Send/Receive Print Organize

Inbox

Folder: E:\My Documents\Leveque\IP\CLIENTS\Agilent\2001\01-AGI-06\APPLICATION

Back Forward Stop Search Folders

Address: E:\My Documents\Leveque\IP\CLIENTS\Agilent\2001\01-AGI-06\APPLICATION

| Name | Size | Type | Modified |
|------------------------------------|--------|-------------------------|-------------------|
| Application - draft #1.DOC | 119 KB | Microsoft Word Document | 8/14/2001 3:20 PM |
| Application - draft #2.DOC | 134 KB | Microsoft Word Document | 8/14/2001 3:47 PM |
| Application - draft #3.DOC | 121 KB | Microsoft Word Document | 9/11/2001 2:51 PM |
| Application - final - password.DOC | 124 KB | Microsoft Word Document | 9/11/2001 3:35 PM |
| Application - final.DOC | 124 KB | Microsoft Word Document | 9/11/2001 3:36 PM |
| 10010804AsFiled.PDF | 999 KB | PDF File | 9/23/2003 3:50 PM |

APPLICATION

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5 Objects (Disk free space: 30.9 GB)

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EXHIBIT C

Michelle Larson

From: "Michelle Larson" <michelle@larsonpc.com>
To: "HEBERT,SUE (A-Loveland,ex1)" <sue_hebert@agilent.com>
Cc: "Michelle Larson" <michelle@larsonpc.com>
Sent: Tuesday, September 11, 2001 3:58 PM
Subject: 10010804-1 (01-AGI-06) application

[REDACTED]

I will be sending you via a separate e-mail the electronic files for this patent application, including the spec, foreign claims, and foreign abstract. The password for the files is "patent."

[REDACTED]

[REDACTED]

Regards,
Michelle Larson

9/11/2001

Michelle Larson

EXHIBIT D


From: "Michelle Larson" <michelle@larsonpc.com>
To: "HEBERT,SUE (A-Loveland,ex1)" <sue_hebert@agilent.com>
Cc: "Michelle Larson" <michelle@larsonpc.com>
Sent: Tuesday, September 11, 2001 3:59 PM
Attach: ABSTRACT FOR FOREIGN FILING - password.doc; CLAIMS - FOREIGN FILING - password.doc;
application - final - password.DOC
Subject: 10010804-1 application

9/11/2001

Michelle Larson

EXHIBIT E

From: "HEBERT,SUE (A-Loveland,ex1)" <sue_hebert@agilent.com>
To: <michelle@larsonpc.com>
Sent: Thursday, September 20, 2001 10:02 AM
Subject: case 10010804-1



Michelle,

I just wanted to let you know that the inventors had no changes and I filed the case on 9/18/01.

Sue Hebert

9/20/2001

EXHIBIT F.

Measurement Algorithm Variation

Prior Solutions

Most prior solutions to this problem are either to provide the source code to a measurement algorithm or to break the algorithm down into small "chunks" to be recombined by the user in the context of the variation needed.

The disadvantages of the source code approach are the loss of proprietary knowledge from making the code public and the support problem caused by defects introduced from user modification of the code.

The disadvantage of the "chunking" approach is the documentation and training required for the user to take advantage of the measurement code.

Approaches used in other domains include inheritance, extensions, parameterization, templates, code generators, design patterns, and plug-ins. All of these except plug-ins require user access to and modification of the source code and therefore the proprietary algorithm. A Plug-in is one approach to solving the measurement problem, but it has never been applied in this context.

Problems Solved by This Invention

Agilent provides measurement knowledge for our customers in the form of reusable code modules. This measurement knowledge is valuable and it often embodies proprietary knowledge. Unfortunately not all application conditions can be anticipated when the code is written. Therefore, the customer must have the ability to affect some parts of the measurement algorithm. For instance, a new device may have an unexpectedly slow response time under some conditions. Delays may have to be inserted in the measurement algorithm at certain points to make the device work correctly. Another problem is that Device Under Test (DUT) state may have to be coordinated with the measurement algorithm state. Traditionally, we have had to provide the source code to the user to allow them to change or augment the algorithms.

This invention provides means for Agilent to open parts of the measurement algorithm to our users for optional modification without having to show source code or document all implementation details. This gives the users the ability to easily modify certain aspects of the behavior without a complex programming task. It also preserves the main functional behavior of the measurement algorithm. That is, it does not have to be re tested or characterized to the same level of detail that would be required if the user directly modified the core measurement algorithm.

Advantages over Prior Solutions

The source code remains proprietary to Agilent.

Users have the ability to modify selective behavior without invalidating the measurement algorithm.

Users can modify some behavior without having to understand the entire algorithm.

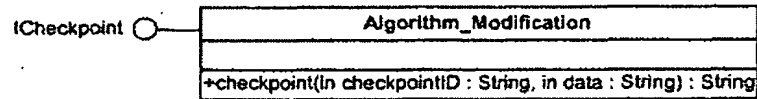
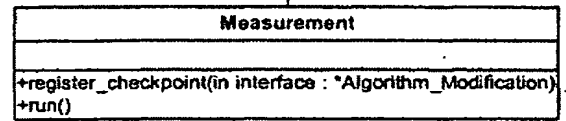
The user's customization ability is easier to document.

Description of the Invention

A measurement will include one or more "variation points" in its algorithm. These are points in the code where the designer anticipates that the user might wish to modify or interact with the algorithm. A variation point will contain a "call-out" (often called an outgoing interface) to user supplied code. The call-out will contain information about the current state of the measurement. The user can take any required action, such as inserting a short delay, controlling the Device Under Test, or modifying the existing measurement algorithm. The user code then returns to the measurement algorithm for normal processing.

There are several possible variations on the technology for performing the call-out and the type of parameters and control information communicated. Some of the call-out variations are: calls into well-known functions in defined DLL's, Connection-Point interfaces (Visual Basic "Events"), an event server, instantiation of defined COM server interfaces, invocation of COM interfaces passed in to the measurement algorithm, use of CORBA-based servers, use of Enterprise Java Beans as an interface mechanism, use of SOAP or Microsoft web services as the interface mechanism.

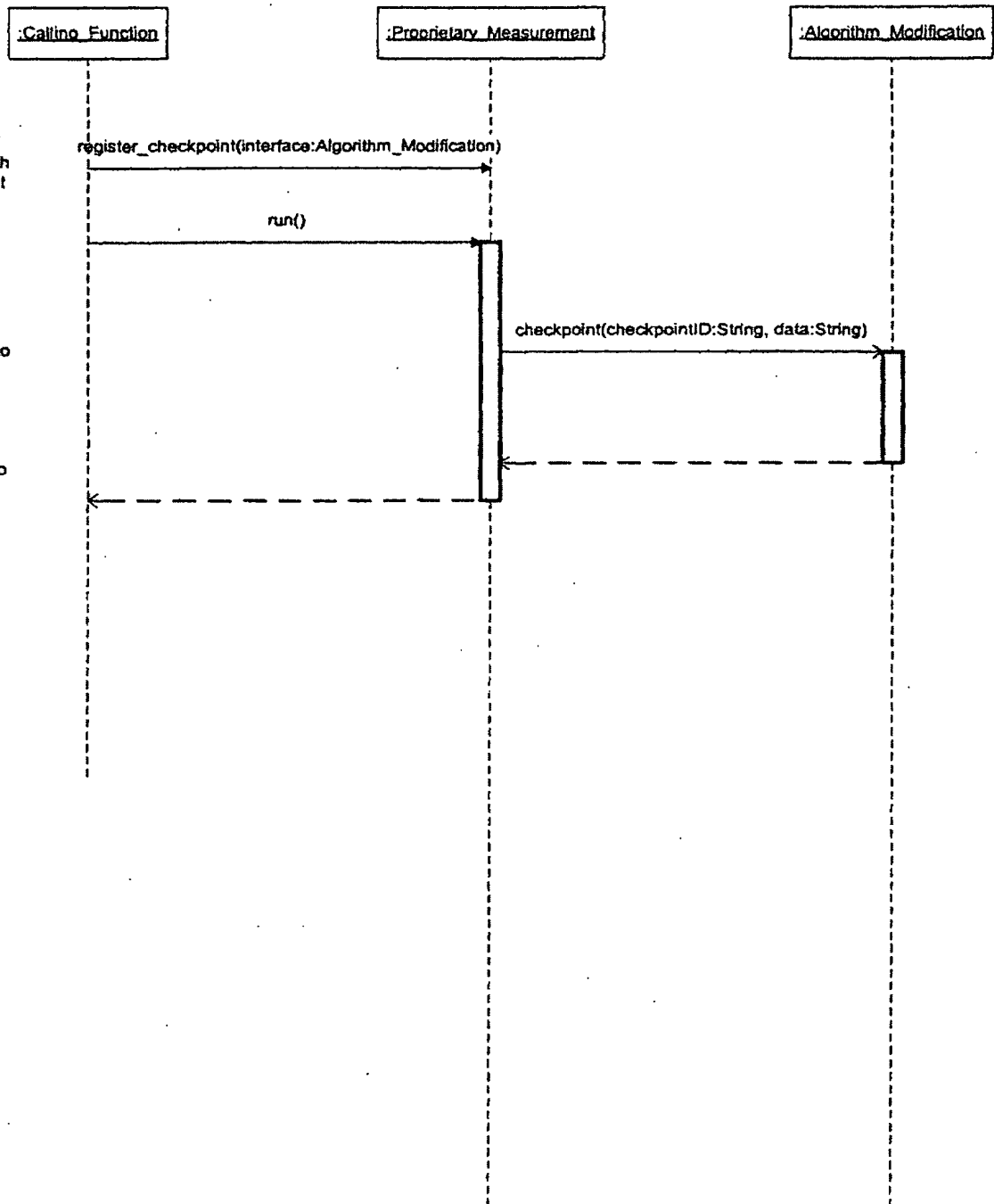
Some of the variants of the control information are: each variation point calls a separate interface, each variation point calls the same interface and passes a parameter to describe the variation point location, a variation point call-out can contain a "cancel" parameter to allow the user to override a decision or cancel an operation, a variation point can contain instruction codes to be sent to an instrument to allow user edit or optimization, and a variation point can pass codes to allow the user to select options or algorithms from several alternatives offered by the measurement algorithm.



Register the interface of the modifying function with the original measurement code.

Invoke the standard measurement

At some point the measurement calls the modifying function given to it via the register_checkpoint method. This modifying function takes whatever action is appropriate before returning control to the measurement.



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